

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: **Banerjee et al.**

Serial No. **09/915,436**

Filed: **July 26, 2001**

For: **Method and Apparatus For
Insuring Delivery of Electronic
Documents in a Network Data
Processing System**

§
§
§
§
§
§
§

Group Art Unit: **3692**

Examiner: **James A. Kramer**

**Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450**

35525
PATENT TRADEMARK OFFICE
CUSTOMER NUMBER

REPLY BRIEF (37 C.F.R. 41.41)

This Reply Brief is submitted in response to the Examiner's Answer mailed on November 24, 2006.

No fees are believed to be required to file a Reply Brief. If any fees are required, I authorize the Commissioner to charge these fees which may be required to IBM Corporation Deposit Account No. 09-0447.

RESPONSE TO EXAMINER'S ANSWER

Generally speaking, in the Examiner's Answer the Examiner has changed certain rationale and reasoning for rejecting many claims – although the claims remain rejected under the same ground of statutory rejection – thus prompting this Reply Brief. The Examiner apparently now acknowledges that certain previously articulated claimed features are not taught or suggested by any of the cited references, and in an attempt to overcome such failure to properly establish a *prima facie* case of obviousness, now relies on conjecture and subjective assertions that the missing claimed features would have been obvious without providing credible, objective evidence to support such conjecture and subjective assertions, as will now be shown in detail.

On page 7 of the Examiner's Answer, it is stated that 'The use of selected indicates that a system first presents the user with an amount based and be selected (sic) prior to the permission activated event', and that it is the Examiner's position that this teaching of a selected coverage amount represents the claimed limitation of "delivering the electronic document in response to receiving a reply to the acknowledgment from the requestor accepting the identified payment amount". The Examiner's position ignores the particular details of the protocol recited in Claim 1. Per Claim 1, as a part of providing electronic document delivery insurance, a request to insure delivery of an electronic document is received, and *a payment amount is identified and included in an acknowledgment sent to the requestor of the insurance*. The electronic document is then delivered *in response to receiving a reply to this acknowledgment from the requestor, such reply accepting the identified payment amount. The claimed invention thus provides a positive response from the requestor accepting the payment amount before the electronic document is delivered*. The Examiner's assertion only establishes that a payment amount is *selected* by a requestor, and Appellants' urge this is accomplished by the user completing an electronic form (*Cianciarulo* paragraph 0057), which is very different from the above described handshake protocol. Thus, a proper *prima facie* showing of obviousness has not been established with respect to Claim 1.

On page 8 of the Examiner's Answer, the Examiner now acknowledges that *McCabe's* enumerated risk factors - which are relied upon by the Examiner in rejecting Claim 6 – do not necessarily work effectively with data and online presence due to the lack of predictability, but now

the Examiner takes the position that such practices are effective for more predictable areas. Appellants respectfully urge that the claims are specifically directed to data and online presence – which is the unpredictable venue which *McCabe* expressly scorns, so whatever more predictable areas that the Examiner alludes to is not material to Claim 6 as such claim is directed to the unpredictable area which *McCabe* scorns. In any event, the *McCabe* reference does not teach or suggest the specific claimed feature of “wherein the network characteristics are maintained in a *network database which is queried in response to identifying a delivery location for the electronic document* such that the identified payment amount is based on actual network characteristics of the network in which the electronic document is to be transmitted”. Thus, a proper *prima facie* showing of obviousness has not been established with respect to Claim 6.

Also on page 8 of the Examiner’s Answer, in discussing points A.3-A.5, the Examiner opines that “If the amount of time were not a factor then there would be no way to prove that a document was not delivered. In other words, there must be an amount of time figured into the coverage fee”. Applicants urge that to the contrary, the cited *Cianciarulo* reference expressly teaches that the fees may in fact be a flat periodic fee charge (*Cianciarulo* paragraph 0043). Thus, and contrary to the Examiner’s assertion, there is no requirement that an amount of time be figured into the coverage fee. As to the Examiner’s reliance on a *Cardot* reference – which is not being used in the formal claim rejection and thus whose relevance is unclear – as showing inherent features of the cited *Cianciarulo* reference, it is urged that the mere fact that this *Cardot* reference describes a Portogo Insurance protection system, and that Portogo Insurance is the assignee of the cited *Cianciarulo* reference, does not establish any inherent features of the cited *Cianciarulo* reference. For example, this Portogo Insurance commonality does not provide any linkage that these two documents describe the same underlying system. Even further, the fact that clients can insure data just as they would insure data sent by conventional mail only states that the *client* is able to insure an item. This statement does not describe any internal processes used by the *insurer* in providing such insurance or associated rate setting. In any event, the cited *Cianciarulo* reference expressly teaches a flat rate for insurance, as previously described above, which is not time based. Thus, a proper *prima facie* showing of obviousness has not been established with respect to claims identified in headings A3-A5.

On page 11 of the Examiner's Answer, in the portion of the claim chart directed to the two claimed steps of "sending an acknowledgment of the electronic document to the requestor, wherein the acknowledgment includes the identified payment amount" and "delivering the electronic document in response to receiving a reply to the acknowledgment from the requestor accepting the identified payment amount", it is noted (and as previously described above) that the *Cianciarulo* permission activated event may be the delivery of the document, but such delivery is not in response to *receiving a reply to the acknowledgment* (where the acknowledgement includes the identified payment amount which was identified in response to receiving a request from a user) from the requestor *accepting the identified payment amount*, as claimed. Thus, a proper *prima facie* showing of obviousness has not been established with respect to Claim 1.

Still further on this same page 11, the Examiner maintains that 'Appellant's "acknowledgement" is interpreted as sending the user a quote for the insurance'. Appellants urge that whether or not we, as Appellants, acknowledge anything is not germane to whether Claim 1 is obvious in view of the cited references. In any event, an 'acknowledgement' as such term is commonly known to those of ordinary skill in the art is not equivalent to 'sending the user a quote for insurance', as alleged by the Examiner. Thus, a proper *prima facie* showing of obviousness has not been established with respect to Claim 1.

On page 14 of the Examiner's Answer, the last two lines, the Examiner states that by arguing that the fees of *Cianciarulo* are determined without relying (on) network characteristics, Appellant is asserting that the fees are determined *at random* (emphasis added by Appellants). Appellants urge that, to the contrary, and as expressly described by the teachings of *Cianciarulo* at paragraph 0040 lines 4-20, the fees charged are preferably determined by preexisting business rules established during a previously formed contractual relationship such that additional user input is not required (*Cianciarulo* paragraph 0040, last sentence), and such previously negotiated fees may actually have been previously agreed upon to be a *flat fee* (*Cianciarulo* paragraph 0043). Such pre-existing business rules and previous contract negotiations to establish fees *are clearly not random*, as alleged by the Examiner to be the result of Appellant's position. Thus, Appellants position has merit, and is not unreasonable or absurd or contrary to standard business practices.

On page 15 of the Examiner's Answer, the Examiner asserts that such claim is directed to, and directly contrary to Appellant's position, an 'after-the-fact' occurrence as it determines if the document has been delivered (emphasis by the Examiner). Appellants urge that to the contrary, Claim 8 recites:

analyzing the electronic document to identify an *estimated amount of time* in which the electronic document can be delivered

which is a 'before-the-fact' occurrence. Appellants urge that determining/proving that a document was delivered or not (an 'after the fact' occurrence with respect to delivery), as alleged to be taught by the cited references, is a totally different concept from using an *estimated* amount of time in which a document *can* be delivered (a 'before the fact' occurrence with respect to delivery). Accordingly, the assertion with respect to actual document delivery and proof thereof provides no teaching or suggestion of the specific claimed features recited in Claim 8 with respect to *estimated amounts of time that are identified* using a network database that maintains network characteristics of a network to be used in the delivery of the electronic document. Thus, a proper *prima facie* showing of obviousness has not been established with respect to Claim 8.

On page 16 of the Examiner's Answer, on the bottom half of the page, the Examiner opines as to various post office operations, yet such operations are not the basis for the current rejection (instead, the claims are rejected based on the teachings of *Cianciarulo* and *McCabe*), and thus are not seen to provide any objective evidence of obviousness.

Still further, and as evidenced by the following information from the US Postal Service web page at www.usps.gov, insurance is value based and not time based. Thus, even if the post office operations were properly of record in the current claim rejection, such operations do not in fact establish any type of network-characteristic or time-based pricing.

INSURED MAIL

You have several options for adding security to the gifts and merchandise you send.

Security is key when you're sending valuables through the mail. Whether you are sending jewelry, antiques or just expensive clothing, getting insurance provides that security.

Insure your package only for what its contents are worth; you're only covered for the actual value at the time and place of mailing.

Fee Insurance Coverage

\$1.35 \$0.01 to \$50

\$2.30 \$50.01 to \$100

\$3.35 \$100.01 to \$200

\$4.40 \$200.01 to \$300

\$5.45 \$300.01 to \$400

\$6.50 \$400.01 to \$500

HOW TO FILE INSURANCE CLAIMS

If your insured shipment, whether Insurance was purchased online or at a Post Office, has been lost or damaged in transit you can request to recover the value of your articles by filing an insurance claim at any Post Office.

► Domestic Claims

- Shipments mailed domestically (to or from any address in the United States) . APO/FPO shipments included.
- Claims for all services, except Merchandise Return Service can be filed at any Post Office. Merchandise Return Service claims can only be filed at the Post Office where the Merchandise Return permit is held.
- Download PS Form 1000, Domestic Claim or Registered Mail Inquiry, and complete the customer portion. You may submit the completed form to any U.S. Post Office.
- With the completed claims form you will need to provide evidence of Insurance and evidence of value.
- Depending on the type of claim, you will need to provide proof of damage, proof of loss, or partial loss of contents.

While it may be true that the cost to deliver an item is more expensive for overnight mail than 2-3 day mail, cost of delivery is very different from the cost of insurance, and the evidence of record has not established any teaching or suggestion of any network-characteristic or time-based pricing for insurance.

On page 17 of the Examiner's Answer, the Examiner takes the position that *McCabe's* teaching of "observing defined events across large groups of people or entities" clearly relates to

the characteristics of the network with which the data is being transmitted. Applicants urge that this is not only not the case, but as described above *McCabe* expressly scorns traditional probability of loss in an online data environment due to it being unreliable, and thus a person of ordinary skill in the art would not interpret *McCabe*'s "probability of loss" to mean "reliability properties of a network". Thus, a proper *prima facie* showing of obviousness has not been established with respect to Claims 9-11, 14, 22-24 and 26.

On page 18 of the Examiner's Answer, the Examiner appears to take the position that use of network characteristics is inherent in establishing a payment. As previously discussed, such payments may be the result of a pre-existing contractual relationship with fixed/flat fees, and thus use of network characteristics in establishing a payment is not inherent to the teachings of the cited references¹.

On page 19 of the Examiner's Answer, the Examiner equates *Cianciarulo*'s 'timely delivery' with the claimed feature of 'estimated time of delivery'. These phrases mean very different things, as one is after-the-fact (the thing has been timely delivered) and the other is before-the-fact (an estimated time of delivery). By providing both an insurance cost and an estimated time of delivery, as per the features of Claim 12, a resulting advantage is that a user requesting insurance is able to adequately determine if the level of service (estimated time of delivery) and cost (insurance cost) is satisfactory. None of the cited references teach or suggest this claimed feature or its resulting advantage. For example, the cited *Cianciarulo* reference merely teaches insurance payouts if a document is not received at all, without any consideration being given as to whether the document was delivered within a particular window of time (page 6, paragraph 0044). Thus, it is urged that a proper *prima facie* case of obviousness has not been established with respect to Claim 12.

¹ "To establish inherency," the Federal Circuit recently stated, "the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.'" *In re Robertson*, 169 F.3d 743, 745 [49 USPQ2d 1949] (Fed. Cir. 1999); see also *Continental Can Co. U.S.A., Inc. v. Monsanto Co.*, 948 F.2d 1264, 1268 [20 USPQ2d 1746] (Fed. Cir. 1991). Such inherency may not be established by "probabilities or possibilities." *Continental Can*, 948 F.2d at 1269 (quoting *In re Oelrich*, 666 F.2d 578, 581 [212 USPQ 323] (C.C.P.A. 1981)).

CONCLUSION

It is respectfully urged that a *prima facie* case of obviousness has not been properly established using the cited references of record, and accordingly all claims have been improperly rejected by the Examiner under 35 USC §103. Accordingly, Appellants request that the Board reverse such improper final rejection of all pending claims.

/Wayne P. Bailey/

Wayne P. Bailey

Reg. No. 34,289

YEE & ASSOCIATES, P.C.

PO Box 802333

Dallas, TX 75380

(972) 385-8777